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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,548	11/20/2001	Bernd Luhmann	tesa AG 478.2KGB	8904

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 6/23/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 12-35 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 12-35 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☒ Certified copies of the priority documents have been received in Application No. 08/976,802

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner has withdrawn the 35 U.S.C. § 101 statutory type double patenting rejection of record for reasons set forth by applicants in their response. Additionally, the Examiner has withdrawn the double patenting of the obviousness type rejection of record in view of applicants' terminal disclaimer which has been filed.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

4. A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO -691, substantially for reasons of record relating to the earlier relied upon obviousness rejection over this reference such as were set forth most extensively in both paragraph No. 6 of Paper No. 4 and paragraph No. 4 of Paper No. 6, together with the following additional observations. Upon reconsideration, the Examiner has decided that his earlier

rationale set forth in the last paragraph of paragraph No. 4 of Paper No. 6 wherein it was stated "The reference may well be an anticipation except for the fact that it teaches such a large number of embodiments that a reduction to practice of the genus of adhesives which anticipates the claimed invention is too difficult a task" because it is believed that a very large number of anticipating embodiments are taught by the reference so that anticipation does, in fact, exist. That is, in a large number of embodiments the reference teaches adhesive tapes which can be released from a substrate without leaving a residue or damaging the substrate by pulling thereon, wherein backings such as foam backings of the requisite thickness and exhibiting the requisite modulus of elasticity are disclosed, together with a broad genus of adhesives of which a significant number of these read upon the adhesive compositions claimed by applicants, and therefore the adhesive tape would presumably function in the identical manner as the claimed adhesive tapes. With respect to the whereby clause in claim 24 in which applicants are on record as stating that this clause defines what the Examiner believes is a well known fact; namely, that the type and amount of adhesive influences the removable characteristics of the tape and this fact is believed to be, if not inherently taught by the reference is at most an obvious optimization of tape removability

properties. Note that since the reference desires the tape article to be readily removed, it would have been either inherent or at most an obvious optimization of properties to have provided a pressure sensitive adhesive with the peel force claimed, particularly since as noted above the reference teaches substantially the same genus of adhesives that applicants contemplate. What other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. Claims 24-35 are rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. More particularly, upon reflection the Examiner has reinserted the new matter rejection which was initially present in paragraph No. 8 of Paper No. 4 for the following reasons. To somewhat reiterate, applicants have argued that this whereby clause in claim 24 has found support particularly in Example 1, and has conveyed the concept of a backing that would tear if not for the presence of the self-adhesive composition. Additionally applicants have previously strenuously argued (Response of

5/5/03, pages 8-9) the fact that "the proper choice of adhesive can provide support and prevent tearing of a backing that would tear under other circumstances" and refers to examples where the only difference admitted between the two samples is the type and amount of adhesive employed. However, the Examiner must simply note that this simply states a well known fact, namely that the type and amount of adhesive utilized in a particular layer(s) structure influences the removable characteristics of the tape, and he also questions what are the "other circumstances" referred to. Additionally, applicants' argument is not seen to be reflected in the whereby clause, which reads, "whereby the backing is selected such that the backing would tear if pulled in the absence of said self-adhesive composition with the same stripping force necessary to remove said adhesive tape from said substrate, but the backing does not tear when said adhesive tape is removed from said substrate." However, the Examiner must note that how does the backing tear if pulled in the absence of said self-adhesive composition? If no adhesive is holding it on the substrate it would seem that it could not tear, and in any event the alleged support for this found in Examples 1 and 2 which has been argued strenuously by applicants is simply not seen to be reflected in the claim language, nor is the limitation that "the concept of a backing can be selected that would tear under a

given set of circumstances and by proper manipulation of the adhesive the backing can be supported by the adhesive in a manner that it will not tear when an adhesive tape comprising it is removed from a substrate" (Response of 5/5/03, page 9, top paragraph). In summary, it is not seen how the whereby clause finds either express or inherent support in applicants' specification, and it is also believed that this clause does not set forth the concepts which applicants have so strenuously argued and accordingly, the Examiner is again upon reconsideration viewing it as new matter.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status

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information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

August 19, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zinker